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09/918,756	07/30/2001	Clayton Neil Cowgill	1087-RIO356 (7916-9)	2745

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EXAMINER	
CHAU, COREY P	
ART UNIT	**PAPER NUMBER**
2644	

DATE MAILED: 02/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/918,756	COWGILL, CLAYTON NEIL	
	Examiner	Art Unit	
	Corey P. Chau	2644	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 January 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,4,8,10 and 17* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,4,8,10 and 17* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This action is in response to the request for continued examination filed on 1/16/2006 in which claims 2-3, 5-7, 9, 11-16, and 19-20 are cancelled and claims 1, 4, 8, 10, and 17 are pending

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 4 recites, "the expansion module is removable from the remote control". Claim 1 discloses "the expansion module resides on a removable component at a location away from the digital audio player" and "the removable component comprises a remote control connected to the digital audio player and the audio outputs". Claim 1 does not discloses the expansion module residing on the remote control, therefore it does not clearly discloses how "the expansion module is removable from the remote control". Therefore it is unclear to the Examiner how "the expansion module is removable from the remote control", when Claim 1 does not discloses the expansion module residing on the remote control.

4. Claim 17 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification as originally filed, does not

support the limitations of "the expansion module includes an additional battery for providing power to the digital audio player" as claimed in claim 17 now. The specification discloses expansion module would typically contain a battery **or** expansion memory. The specification does not have support for the expansion module includes addition memory that is accessible by the digital audio player when the digital audio player audio signals **and** includes an additional battery for providing power to the digital audio player.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 1 and 4 are rejected under 35 U.S.C. 102(a) as being anticipated by U.S. Patent Applicant Publication No. 20010003941 to Sawada et al. (hereafter as Sawada).

7. Regarding Claim 1, Sawada discloses a portable audio device, comprising:

a digital audio player operable to convert digital signals stored in a memory to audio signals (420);

audio outputs operable to allow a user to hear the audio signals (441,442); and

an expansion module operable to provide additional capacity to the digital audio player (Fig. 8; page 5, paragraph 0061), wherein the expansion module resides on a removable component at a location away from the digital audio player, the removable component (400) being communicatively coupled to the digital audio player when the digital audio player is playing audio signals (Fig. 8);

wherein the expansion module includes addition memory that is accessible by the digital audio player when the digital audio player audio signals (Fig. 8); and

wherein the removable component comprises a remote control (405) connected to the digital audio player and the audio outputs (Fig. 8), wherein the remote control is operable to control the digital audio player (page 6, paragraphs 0062).

8. Regarding Claim 4, as best understood with regards to the 112, 2nd problem mentioned above, Sawada discloses the expansion module is removable from the remote control (Fig. 8).

9. Claims 1, 4, 8, and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5892502 to Hiller.

10. Regarding Claim 1, Hiller discloses a portable audio device, comprising:

a digital audio player operable to convert digital signals stored in a memory to audio signals (i.e. personal computer);

audio outputs operable to allow a user to hear the audio signals (i.e. speaker, headphone)(Fig. 1); and

an expansion module (column 2, lines 44-56) operable to provide additional capacity to the digital audio player, wherein the expansion module resides on a removable component (column 1, line 48 to column 2, line 8) at a location away from the digital audio player (Fig. 1), the removable component being communicatively coupled to the digital audio player when the digital audio player is playing audio signals (i.e. the storage device is connected to the personal computer through a standard input port in the same manner as an external CD ROM device . Therefore, the storage device is excess by the personal computer to read the digital files and produce audio signals when, for example a music CD is placed in the CD ROM) (abstract; Fig. 1; column 1, line 48 to column 2, line 8); and

wherein the expansion module includes addition memory that is accessible by the digital audio player when the digital audio player audio signals (column 2, lines 44-56).

wherein the removable component comprises a remote control (Fig. 3; column 2, line 65 to column 3, line 14) connected to the digital audio player and the audio outputs (Fig. 1), wherein the remote control is operable to control the digital audio player.

11. Regarding Claim 4, as best understood with regards to the 112, 2nd problem mentioned above, Hiller discloses the expansion module is removable from the remote control (Fig. 1).

12. Regarding Claim 8, Hiller discloses a portable audio device, comprising:

a digital audio player (i.e. personal computer) operable to convert digital signals to audio signals (Fig. 1), the player comprising:

i) a memory operable to store digital signals (i.e. it is inherent a personal computer comprises a memory operable to store digital signals);

ii) a battery operable to provide power (i.e. it is inherent a personal computer comprises a battery operable to provide power),

iii) a digital to analog converter operable to convert the digital signals to analog audio signals (i.e. it is inherent a personal computer comprises a digital to analog converter operable to convert the digital signals to analog audio signals);

audio outputs operable to allow a user to hear the audio signals (Fig. 1);

a remote control (Figs. 1 and 3; column 2, line 65 to column 3, line 14) in connection with the digital audio player and with the audio outputs, wherein the remote control is operable to allow a user to operate the digital audio player;

an expansion module operable to provide additional capacity to the digital audio player (column 2, lines 44-56), wherein the expansion module resides separate from the digital audio player on the remote control, the remote control being communicatively coupled to the digital audio player when the digital audio player is playing audio signals (i.e. the storage device is connected to the personal computer through a standard input

port in the same manner as an external CD ROM device . Therefore, the storage device is excess by the personal computer to read the digital files and produce audio signals when, for example a music CD is placed in the CD ROM) (abstract; Fig. 1; column 1, line 48 to column 2, line 8); and

wherein the expansion module includes additional memory that is accessible by the digital audio player when the digital audio player is playing audio signals (column 2, lines 44-56).

13. Regarding Claim 10, Hiller discloses the expansion module is removable from the remote control (Fig. 1).

14. Claims 1, 4, 8, and 10 are rejected under 35 U.S.C. 102(a) as being anticipated by U.S. Patent No. 6148243 to Ishii et al. (hereafter as Ishii).

15. Regarding Claim 1, Ishii discloses a portable audio device, comprising:

a digital audio player operable to convert digital signals stored in a memory to audio signals (301)(Fig. 8);

audio outputs operable to allow a user to hear the audio signals (Fig. 8); and

an expansion module (column 7, line 55 to column 8, line 7) operable to provide additional capacity to the digital audio player, wherein the expansion module resides on a removable component at a location away from the digital audio player (Fig. 8), the removable component being communicatively coupled to the digital audio player when the digital audio player is playing audio signals (i.e. the CD ROM is excess by the

personal computer to read the digital files and produce audio signals when a music CD is placed in the CD ROM); and

wherein the expansion module includes addition memory that is accessible by the digital audio player when the digital audio player audio signals (column 7, line 55 to column 8, line 7).

wherein the removable component comprises a remote control (column 7, line 55 to column 8, line 7) connected to the digital audio player and the audio outputs (Fig. 8), wherein the remote control is operable to control the digital audio player.

16. Regarding Claim 4, as best understood with regards to the 112, 2nd problem mentioned above, Ishii discloses the expansion module is removable from the remote control (Fig. 8; column 7, line 55 to column 8, line 7).

17. Regarding Claim 8, Ishii discloses a portable audio device, comprising:

a digital audio player (301) operable to convert digital signals to audio signals (Fig. 8), the player comprising:

i) a memory operable to store digital signals (Figs. 1 and 2);

ii) a battery operable to provide power (i.e. it is inherent a personal computer comprises a battery operable to provide power),

iii) a digital to analog converter operable to convert the digital signals to analog audio signals (i.e. it is inherent a personal computer comprises a digital to analog converter operable to convert the digital signals to analog audio signals);

audio outputs operable to allow a user to hear the audio signals (Fig. 8);

a remote control (Fig. 8; column 7, line 55 to column 8, line 7) in connection with the digital audio player and with the audio outputs, wherein the remote control is operable to allow a user to operate the digital audio player;

an expansion module operable to provide additional capacity to the digital audio player (column 7, line 55 to column 8, line 7), wherein the expansion module resides separate from the digital audio player on the remote control (Fig. 8), the remote control being communicatively coupled to the digital audio player when the digital audio player is playing audio signals (i.e. the CD ROM is excess by the personal computer to read the digital files and produce audio signals when a music CD is placed in the CD ROM); and

wherein the expansion module includes additional memory that is accessible by the digital audio player when the digital audio player is playing audio signals (column 7, line 55 to column 8, line 7).

18. Regarding Claim 10, Ishii discloses the expansion module is removable from the remote control (Fig. 8).

Claim Rejections - 35 USC § 103

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

20. Claims 1 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6606506 to Jones.

21. Regarding Claim 1, Jones discloses a portable audio device, comprising:

a digital audio player operable to convert digital signals stored in a memory to audio signals (18);

audio outputs operable to allow a user to hear the audio signals (12); and

an expansion module (abstract; column 3, lines 9-38) operable to provide additional capacity to the digital audio player, wherein the expansion module resides on a removable component (12) at a location away from the digital audio player (Fig. 5), the removable component (Fig. 5) being communicatively coupled to the digital audio player when the digital audio player is playing audio signals (Fig. 5); and

wherein the expansion module includes addition memory that is accessible by the digital audio player when the digital audio player audio signals (abstract; column 3, lines 9-38).

Jones discloses a remote control/display unit (column 5, line 66 to column 6, line 13; claim 1), but does not expressly disclose the removable component comprises a remote control connected to the digital audio player and the audio outputs, wherein the remote control is operable to control the digital audio player. However, the Examiner takes Official Notice that it is well known that a remote control can be incorporated on the signal line of the headphone in order to allow the user to control the digital audio player without having to wearing an extra accessory/component. Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to

modify Jones to incorporate the remote control/display unit on the signal line of the headphone (12) in order to allow the user to control the digital audio player without having to wearing an extra accessory/component. Therefore the removable component (12) comprises a remote control (i.e. the remote control/display unit incorporated on the signal line (20)) connected to the digital audio player and the audio outputs, wherein the remote control is operable to control the digital audio player.

22. Regarding Claim 4, as best understood with regards to the 112, 2nd problem mentioned above, Jones as modified discloses the expansion module is removable from the remote control (abstract; Fig. 5; column 3, lines 9-38).

23. Claims 1, 4, 8, 10, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication No. 20020080091 to Acharya.

24. Regarding Claim 1, Acharya discloses a portable audio device, comprising:

digital audio player (110), but does not expressly disclose operable to convert digital signals stored in a memory to audio signals. However, the Examiner takes Official Notice that it is well known in the art that the digital audio player (110) is operable to convert digital signals stored in a memory to audio signals in order to allow a user to play the audio signal on the digital audio player (110). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Acharya to have the digital audio player (110) operable to convert digital signals stored in a memory to audio signals in order to allow the user to play the audio signals on the digital audio player (110).

Therefore Acharya as modified discloses:

audio outputs operable to allow a user to hear the audio signals (page 10, paragraph 0111); and

an expansion module operable to provide additional capacity to the digital audio player (Figs. 1 and 6), wherein the expansion module resides on a removable component at a location away from the digital audio player (Fig. 6), the removable component (120) being communicatively coupled to the digital audio player when the digital audio player is playing audio signals (Fig. 6);

wherein the expansion module includes addition memory that is accessible by the digital audio player when the digital audio player audio signals (Figs. 1 and 6);

wherein the removable component comprises a remote control (120,131,132) connected to the digital audio player and the audio outputs, wherein the remote control is operable to control the digital audio player (Figs. 1 and 6)

25. Regarding Claim 4, as best understood with regards to the 112, 2nd problem mentioned above, Acharya as modified discloses the expansion module is removable from the remote control (Figs. 1 and 6).

26. Regarding Claim 8, Acharya discloses a portable audio device, comprising:

a digital audio player (110) operable to convert digital signals to audio signals (Figs. 1 and 6), the player comprising:

i) a memory (Figs. 1 and 6) operable to store digital signals;

ii) a battery operable to provide power (i.e. it is inherent the handheld computing system 110 comprise a battery)(page 10, paragraph 0111), but does not expressly disclose iii) a digital to analog converter operable to convert the

digital signals to analog audio signals. However, the Examiner takes Official Notice that it is well known in the art that the digital audio player (110) is operable to convert digital signals stored in a memory to audio signals in order to allow a user to play the audio signal on the digital audio player (110). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Acharya to have the digital audio player (110) operable to convert digital signals stored in a memory to audio signals in order to allow the user to play the audio signals on the digital audio player (110).

Therefore Acharya as modified discloses:

audio outputs operable to allow a user to hear the audio signals (Figs. 1 and 6);

a remote control (120,131,132) in connection with the digital audio player and with the audio outputs, wherein the remote control is operable to allow a user to operate the digital audio player (Figs. 1 and 6);

an expansion module operable to provide additional capacity to the digital audio player (Figs. 1 and 6; page 3, paragraph 0038), wherein the expansion module resides separate from the digital audio player on the remote control, the remote control being communicatively coupled to the digital audio player when the digital audio player is playing audio signals (Fig. 6); and

wherein the expansion module includes additional memory that is accessible by the digital audio player when the digital audio player is playing audio signals (Figs. 1 and 6; page 3, paragraph 0038).

27. Regarding Claim 10, Acharya as modified discloses the expansion module is removable from the remote control (Figs. 1 and 6).

28. Regarding Claim 17, as best understood with regards to the 112, 2nd problem mentioned above, Acharya as modified discloses the expansion module includes an additional battery for providing power to the digital audio player or includes additional memory for storing digital signals (Figs. 1 and 6).

Response to Arguments

29. Applicant's arguments with respect to claims 1, 4, 8, and 10 have been considered but are moot in view of the new ground(s) of rejection.

30. Applicant's arguments filed 1/16/2006 have been fully considered but they are not persuasive.

31. With respect to Applicant's argument on page 5, stating that "Sawada teaches that the audio reproducing card and receiving unit communicate wirelessly, rather than either being removable from the other", has been noted. However, the Examiner respectfully disagrees. Sawada discloses an audio reproducing card and receiving unit communicate wirelessly, the audio reproducing card and receiving unit is removable from each other, by disconnecting communication. Therefore, Sawada discloses the audio reproducing card and receiving unit being removable from the other.

32. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the removable component **is** a remote control) are not recited in the rejected

claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

33. With respect to Applicant's argument on page 7, stating that "Acharya teaches away from an expansion module residing on a removable component at a location away from the digital audio player, where the removable component is remote control that is operable to control the digital audio player", has been noted. However, the Examiner respectfully disagrees. Acharya does disclose a remote control that is operable to control the digital audio player (120,131,132). See Figs. 1 and 6.

Conclusion

34. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 5717430 to Copland et al. discloses a multimedia computer keyboard.

35. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Corey P. Chau whose telephone number is (571)272-7514. The examiner can normally be reached on Monday - Friday 9:00 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chin Vivian can be reached on (571)272-7848. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

February 21, 2006
CPC

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